Remarks/Arguments:

This amendment does not add or cancel any claims, and is provided to amend claim 1 for clarification only. Accordingly, no new matter has been added or suggested. Upon entry of this amendment, claims 1-60 will be pending, wherein claims 1, 3 and 57 are independent.

Miscellaneous

The Examiner is again requested to provide formal notation of the acknowledgement of receipt of all certified copies of the priority documents. As noted in the previous Office Action of August 8, 2008, boxes 12 and 12(a) are checked, but none of boxes 12(a)(1), 12(a)(2), or 12(a)(3) were checked. Accordingly, the Examiner is requested to provide an Office Action Summary with the next communication in which boxes 12, 12(a), and 12(a)(1) are checked to provide complete acknowledgement.

Rejections of the Claims under 35 U.S.C. 103

The Examiner has maintained the rejection of claims 1-3, 5, 9, 12-17, 19-24, 28-29, 32, 36, 39-44, 46-51, 55 and 56 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0001704 of Chan et al. (hereinafter Chan) in view of U.S. Patent No. 6,833,848 of Wolff et al. (hereinafter Wolff) and U.S. Patent Publication No. 2003/0048848 of Li et al. (hereinafter Li).

Specifically, the Examiner again points to Chan as disclosing an image recording/reproducing apparatus which records and reproduces a plurality of still image files and sound files with respect to a recording medium and provides a display apparatus with a screen of play list indicating sound files being currently reproduced, including a decoder for decoding the still image files and the sound files recorded in the recording apparatus, and a memory for storing the still image files and the sound files as decoded.

The Examiner points to Wolff as disclosing such an image recording/reproducing apparatus further having a main control unit for performing a process operation such that a display menu is displayed in a first predetermined area of the screen of play list, wherein the display menu comprises at least one instruction icon to command an alternating display such

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that the plurality of still image files recorded in the recording apparatus are alternately displayed as commanded, and when the instruction icon is selected during the reproducing of the sound files stored in the memory, one or more files among the stored still image files are alternately displayed as commanded on a second predetermined area of the screen of play list indicating sound files as commanded by the selection of the instruction icon.

The Examiner points to Li as disclosing such an image recording/reproducing apparatus still further having a decoder for decoding and storing the plurality of still image files, such that the plurality of still image files recorded in the recording apparatus are decoded and stored in the memory while the decoder is idle, such that the combination of the Chan, Wolff and Li references purportedly render obvious the system and method as recited by the Applicants in independent claims 1 and 3.

The Examiner first points to Chan as disclosing an image recording/reproducing apparatus which records and reproduces a plurality of still image files and sound files with respect to a recording medium and provides a display apparatus with a screen of play list indicating sound files being currently reproduced, including a decoder for decoding the still image files and the sound files recorded in the recording apparatus, and a memory for storing the still image files and the sound files as decoded.

As noted by the Applicants' earlier response, the Chan reference describes a system and method for providing a still image slide show with background audio. To do so, the system and method is provided to read video and audio data from a storage media, and presents the data via a slide show with background audio as selected by a user. Specifically, the display of the Chan reference is configured such that the user can select the association between the slide show and background audio, even in the case of random association (see paragraph 37 and Fig. 6). However, the Examiner notes that Chan does not disclose a system and method to provide the display menu and each predetermined area and more specifically, the provision of a controller configured to provide the display menu and each predetermined area.

That is, the Applicants recite a system and method wherein a controller is configured to provide screen of play list with at least a first and second predetermined area, such that the

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display menu is displayed in a first predetermined area of the screen of play list, and comprises at least one instruction icon to command an alternating display, such that the plurality of still image files recorded in the recording apparatus are alternately displayed as commanded. The system and method is further configured to, when the instruction icon of the display menu is selected during the reproducing of the sound files stored in the memory, alternately display one or more files among the stored still image files as commanded on a second predetermined area of the screen of play list indicating sound files (see for example, Applicants' Fig. 44, wherein the instruction icons 2110 occupy a first predetermined area of the screen of play list and the slide show window 2120 occupies a second predetermined area of the screen of play list).

Accordingly, the Examiner points to Wolff as disclosing such an image recording/reproducing apparatus further having a main control unit for performing a process operation such that the display menu having at least one instruction icon is displayed in a first predetermined area of the screen of play list, and such that the alternate display of the one or more files among the stored still image files is provided on a second predetermined area of the screen of play list as commanded by the instruction icon.

As noted in the Applicants' earlier response, the Wolff reference describes a system and method for storing, authoring and viewing various forms of digital media. To do so, the system and method provides for the receipt of a media, such as a media card, and the display of one or more media objects in a reduced visual representation (see Abstract). A first display area is provided at a top of a screen to show images for browsing and navigating (see 102, Fig. 1), and a second display area is provided at a bottom of a screen to show an enlarged image of a selected item of the first display area (see 103, Fig. 1). The third display area shows audio narrations that are available for the display of the second area (see 104, Fig. 1). Further, a number of control buttons are provided to start a story playback, as described in greater detail below (see Fig. 2).

The system and method of Wolff provides for the receipt of a media, such as a media card, and the display of one or more media objects in a reduced visual representation. The tracks 105, 110 and 115 of the alleged first display area 102 are provided at a top of a screen

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to show images for browsing and navigating (see Fig. 1). However, the Applicants first assert that the tracks or thumbnail images thereof do not provide a display menu and more specifically, do not provide instruction icons, but simply a display of stored images.

The Applicants recite a system and method wherein the first predetermined area is an area for displaying a display menu including one or more instruction icons for executing a slide show, and the second predetermined area of the screen of play list is an area for showing still image files as a slide show as commanded by the selection of the instruction icon. For example, the Applicants' Fig. 44 illustrates one example of the first predetermined area, that is, the area of the slide show instruction icon 2110, and illustrates one example of the second predetermined area, that is, the area of the reference numeral 2120. In doing so, the exemplary screen of play list recited by the Applicants describes the display of the sound file being played at a left side, and the first predetermined area describes an area for displaying a display menu including one or more instruction icons, that is for example, the "repeat all" instruction icon, and the "slide show" instruction icon, to command the alternating display of the plurality of still image files at the second predetermined area. These icons are provided not as buttons, but instruction icons of the display area and more specifically, instruction icons of the first predetermined area of the display area.

However, Fig. 1 of Wolff shows still images along an upper portion of the display, but fails to describe such still images of an alleged first predetermined area as a menu of instruction icons. Specifically, the area 102 of Wolff, including tracks 105, 110 and 115, shows the sequential arrangement of images, and the area 103 shows an enlarged image selected from the area 102. That is, area 103 shows the single enlarged image of the selected image, and is not described as providing a slide show window initiated simply by the operation of the thumbnail images of area 102. Using the thumbnail images of area 102 results in *single image display control* in area 103. As described in greater detail below, *slide show operation* in this area 103 requires operation of the button 220 (see Fig. 2 and col. 7, lines 34-56).

In response to the Applicants' above arguments, the Examiner points to the display area 102 of Wolff as describing a display menu of a first area wherein at least one of the

thumbnail images of tracks 105, 110 and 115 describe an instruction icon. However, in regard to such thumbnail images, the Wolff reference describes these as "graphical representation for browsing and navigating through media objects". A yellow vertical line 255 can be provided to identify the chosen thumbnail image. Further, pointing to a particular thumbnail selects the thumbnail image, selects the track the thumbnail image is on, and displays the corresponding large image in the central area (see col. 6, lines 45-51). The Examiner asserts that this operation commands the alternating display of the plurality of still image files at the second predetermined area. However, as noted above, using the thumbnail images of area 102 only, results in the single enlarged image of area 103 and not an alternating display. Using the thumbnail images of area 102 results in *single image display control* in area 103. The *slide show operation* in this area 103 requires operation of the button 220.

To generate an alleged alternating display in area 103 in the Wolff reference, the separate play button 220 is used to begin the playback of the story from the currently selected thumbnail image and automatically scroll forward through the thumbnail images as output at the area 103 (see col. 7, lines 49-56). As such, the button 220 at the left of Fig. 2, is used to command the play of the story, and not an alleged instruction icon of the display menu or area 102. At most, the use of the thumbnail images of area 102 provides a starting point for the story commencement when the button 220 is used.

That is, a user may select an image using the thumbnail images of area 102 in Wolff, but this alone simply results in a single enlarged image. To play the story which allegedly describes the alternating display as recited by the Applicants, the user must use the play button 220. Accordingly, the Applicants assert that the *thumbnail images* of tracks 105, 110 and 115 of area 102, do not describe an *instruction icon* and more specifically, an *instruction icon of a display* that when selected, commands the alternate display of images at the second predetermined area of the screen. In the case where the thumbnail images of tracks 105, 110 and 115 of area 102 allegedly describe any instruction icon, the command using such icons results in the display of a *single image only*. To display the story, the button 220 must be used, which is not part of the display menu (see again, Wolff Fig. 2).

In the final office action of December 29, 2009, the Examiner states that it is the activation of the play button 220 in the Wolff reference that generates the alternating display, and describes the system and method as recited by the Applicants. However, the Applicants note that it is not an *instruction icon* of Wolff that commands the alternating display, but the hard button 220 in the Wolff reference. Accordingly, the Applicants again assert that even in the case where the thumbnail images of tracks 105, 110 and 115 of area 102 allegedly describe any instruction icon, the command using such icons does not generate the alternating display as recited by the Applicants. To display the story in he Wolff reference, the button 220 must be used, which is not part of the display menu nor an instruction icon and more specifically, an instruction icon of the display menu.

The Examiner also points to Li as disclosing such an image recording/reproducing apparatus still further having a decoder for decoding and storing the plurality of still image files, such that the plurality of still image files recorded in the recording apparatus are decoded and stored in the memory while the decoder is idle. However, the Li reference is not cited for describing the main control unit or display menu having at least one instruction icon in a first predetermined area and the alternate display of the files as commanded by the instruction icon in a second predetermined area.

Accordingly, the Applicants assert that the Wolff, Chan and Li references fail to describe or reasonably suggest a system and method to provide a display menu having at least one instruction icon in a first predetermined area, such that the alternate display of the one or more files among the stored still image files is provided on a second predetermined area of the screen of play list as commanded by the selection of the instruction icon of the first predetermined area. For these reasons, the Applicants assert that the Wolff, Chan and Li references do not disclose or reasonably suggest, separately or in combination, each element as recited by the Applicants in independent claims 1 and 3, and respectfully request the withdrawal of the rejection under 35 U.S.C. 103(a).

Regarding dependent claims 2, 5, 9, 12-17, 19-24, 28, 29, 32, 36, 39-44, 46-51, 55 and 56, the Examiner, in addition to the reasons stated above, further points to Wolff and Chan as disclosing the subject matter of each, purportedly anticipating the system and method as recited by the Applicants.

However, for the reasons stated above, the Applicants assert that the Wolff, Chan and Li references do not disclose or reasonably suggest, separately or in combination, each element as recited by the Applicants in independent claims 1 and 3, from which claims 2, 5, 9, 12-17, 19-24, 28, 29, 32, 36, 39-44, 46-51, 55 and 56 depend. Accordingly, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. 103(a) of dependent claims 2, 5, 9, 12-17, 19-24, 28, 29, 32, 36, 39-44, 46-51, 55 and 56 for the same reasons.

The Examiner has also maintained the rejection of claims 4, 30 and 31 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2002/0033889 of Miyazaki (hereinafter Miyazaki) and has maintained the rejection of claims 6 and 33 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2001/0056434 of Kaplan et al. (hereinafter Kaplan).

However, for the reasons stated above, the Applicants assert that the Wolff, Chan and Li references do not disclose or reasonably suggest, separately or in combination, each element as recited by the Applicants in independent claims 1 and 3, from which claims 4, 6, 30, 31 and 33 depend. Accordingly, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. 103(a) of dependent claims 4, 6, 30, 31 and 33 for the same reasons.

The Examiner has also maintained the rejection of claims 7 and 34 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2002/0136539 of Nakaya (hereinafter Nakaya) and has maintained the rejection of claims 8 and 35 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2002/0012522 of Kawakami et al. (hereinafter Kawakami).

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The Examiner has also maintained the rejection of claims 10, 11, 37 and 38 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2003/0123853 of Iwahara et al. (hereinafter Iwahara), and has maintained the rejection of claims 18 and 45 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent No. 7,315,389 of Kuwata et al. (hereinafter Kuwata).

However, for the reasons stated above, the Applicants assert that the Wolff, Chan and Li references do not disclose or reasonably suggest, separately or in combination, each element as recited by the Applicants in independent claims 1 and 3, from which claims 7, 8, 10, 11, 18, 34, 35, 37, 38 and 45 depend. Accordingly, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. 103(a) of dependent claims 7, 8, 10, 11, 18, 34, 35, 37, 38 and 45 for the same reasons.

The Examiner has also maintained the rejection of claims 25 and 52 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2002/0141580 of Okuyama (hereinafter Okuyama), and has maintained the rejection of claims 26 and 53 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2001/0055465 of Inoue (hereinafter Inoue). The Examiner has also maintained the rejection of claims 27 and 54 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent No. 5,969,719 of Tsujimoto (hereinafter Tsujimoto).
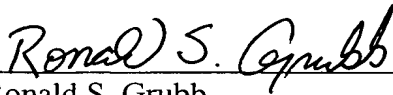
However, for the reasons stated above, the Applicants assert that the Wolff, Chan and Li references do not disclose or reasonably suggest, separately or in combination, each element as recited by the Applicants in independent claims 1 and 3, from which claims 25-27 and 52-54 depend. Accordingly, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. 103(a) of dependent claims 25-27 and 52-54 for the same reasons.

Conclusion

In view of the above, it is believed that the application is in condition for allowance and notice to this effect is respectfully requested. Should the Examiner have any questions, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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